

REMARKS

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

2. Claims 13, 32-39, and 42-47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,208,531. Although the conflicting claims are not identical, they are not patentably distinct from each other because the encapsulated transformer compartment and circuit of 6,208,531 would perform the functions as claimed.

This application is a divisional of application 08/631,793 from which U.S. Patent 6,208,531 issued. Claims 13 and 32-39 were originally presented in that application and were withdrawn by the applicant's election of other claims after a restriction requirement was imposed in a telephone conversation of February 13, 1995. The office action of March 10, 1995, in that application stated:

During a telephone conversation with David L. Feigenbaum on February 13, 1995 a provisional election was made without traverse to prosecute the invention of a power converter, claims 1-12 and 15-24. Affirmation of this election must be made by applicant in responding to this Office action. Claims 13, 14, and 25-41 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

The applicant affirmed that election in response to that office action and filed this divisional application including the non-elected claims. The third sentence of 35 U.S.C. 121 provides that

A patent issuing on an application with respect to which a requirement for restriction under this section has been made ... shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application ... if the divisional application is filed before the issuance of the patent on the other application.

Because the present application is such a divisional application, and a restriction requirement was imposed in the parent application, the double patenting rejection is improper and should be withdrawn.

Claim Rejections - 35 USC § 103

3. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Roszyk et al. (US 3,840,795).

Regarding claim 13, AAPA discloses apparatus comprising a power converter (10) having a first circuitry in the form of a switch (20) to form a first discrete physical unit and connected to respond to control information received from second circuitry in the form of a voltage sensor in a second discrete physical unit, the two physical units respectively including subparts of a device (22) for conveying control information via a galvanically isolated electromagnetic path (page 1, lines 15 through page 2, line14).

AAPA disclose everything claimed except the first and second units being discrete and encapsulated. Roszyk et al. teach a power converter circuit (figure 6) having first and second discrete encapsulated units (11, 12, col. 6, lines 26-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to encapsulate the unit in order to protect the user from shock hazard.

The Background section does not disclose “first circuitry encapsulated to form a first discrete physical unit” or “second circuitry encapsulated to form a second discrete physical unit.” Without two discrete units in the first place, it cannot have disclosed the two discrete encapsulated units including “subparts of a device” for conveying the control information. The control circuit 22 in figure 1 to which the examiner refers is clearly shown as a single unit, not divided into subparts.

In Roszyk, all control electronics are in the power unit – none are in the charging unit, and no control information is conveyed from one unit to the other. (see, e.g., Figs. 4 & 6 and col. 6, line 26 – col. 7, line 9.) Roszyk does not describe and would not have made obvious “subparts of a device for conveying control information” being included in the two physically separated units.

As neither the applicant's Background nor Roszyk includes two discrete and encapsulated units each “including subparts of a device” for conveying control information, the combination of AAPA and Roszyk would not have made obvious claim 13.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good

Applicant : Patrizio Vinciarelli et al.
Serial No. : 09/717,453
Filed : November 21, 2000
Page : 7 of 7

Attorney's Docket No.: 00614-042002 / Brains Div.

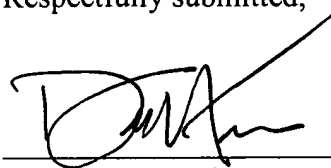
reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

Enclosed is a \$450 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, attorney docket 00614-042002.

Respectfully submitted,

Date: _____

11/13/6



David L. Feigenbaum
Reg. No. 30,378

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906